

**FEB 04 2002**

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In re Application of :
SAWHILL, Robert Arthur, et al. :
Application No.: 09/786,740 :
PCT No.: PCT/SG98/00068 :
Int. Filing Date: 09 September 1998 :
Priority Date: :
Attorney Docket No.: A34089 PCT USA :
For: INTERFACE DEVICE BETWEEN :
TESTING EQUIPMENT AND :
INTEGRATED CIRCUIT :

DECISION ON
PETITION UNDER
37 CFR 1.47(a)

This is in response to applicants' "PETITION PURSUANT TO 37 C.F.R. §1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 23 October 2001 and on 14 December 2001 via facsimile.

BACKGROUND

On 09 September 1998, applicants filed international application PCT/SG98/00068. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 16 March 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 04 April 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 09 March 2001.

On 08 March 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 23 April 2001, USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required. The NOTIFICATION set a two-month extendable period for reply.

On 23 October 2001, applicants filed "Petition Pursuant to 37 C.F.R. §1.47(a)" accompanied by, *inter alia*, a petition for a four-month extension of time, the fee for a four-month extension of time, the Notification of Missing Requirements dated 23 April 2001, an assignment, a combined declaration and power of attorney and a declaration under 37 CFR §1.47(a).

On 06 December 2001, USPTO mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) informing applicants that the application had gone abandoned for failure to timely respond to the Notification of Missing Requirements (Form PCT/DO/EO/905).

On 14 December 2001, applicants submitted faxed copies of the 23 October 2001 petition under 37 CFR 1.47(a), which were accompanied by, *inter alia*, a petition for a four-month extension of time; the fee for a four-month extension of time; a declaration of the inventors executed by Robert Arthur Sawhill; a declaration of Mr. Sawhill; and a copy of a letter to Mr. Shah and the registered article delivery receipt marked "Undeliverable." A copy of the Notification of Missing Requirements (Form PCT/DO/EO/905) was not included.

DISCUSSION

It is first noted that the "Petition Pursuant to 37 C.F.R. §1.47(a)" filed 23 October 2001 is a proper reply to the Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 23 April 2001. Accordingly, the Notification of Abandonment mailed 06 December 2001 was erroneously issued and is hereby vacated.

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Items (1), (3) and (4) have been met. (1) Applicant paid the \$130 petition fee by check. The check was applied to the \$130 late declaration fee. As such, the petition fee of \$130 will be charged to deposit account no. 02-4377. (3) The petition lists the last known address of the non-signing inventor Paren Shah as 10 Rose Lane #01-01, Singapore 429076. (4) The declaration submitted is accepted as complying with 37 CFR 1.47(a).

Item (2) has not been met. Applicants assert that the nonsigning inventor cannot be reached after diligent effort. It is noted that had this petition been based on the refusal of inventor to sign the declaration, applicants would have had to demonstrate that *bona fide* attempt was made to present a copy of the application papers to the inventors. MPEP 409.03(d).

Under 37 CFR 1.47(a), the petition must supply proof of pertinent facts. It is noted that "copies of documentary evidence, such as a internet searches, certified return mail receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached" should be included. MPEP §409.03(d). Applicants submitted a copy of the registered article delivery receipt. However, the statement by inventor Sawhill is general. He states, "I have been unable to locate Mr. Shah because he is no longer in contact with Spire Technologies or its personnel." However, "a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made." MPEP §409.03(d). In particular, such a statement should outline what additional steps (e.g. telephone

search, internet search, *etc.*) were taken to locate the missing inventor beyond merely attempting contact at the last known address.

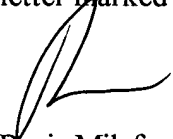
CONCLUSION

For the above reasons, the NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) is **VACATED**.

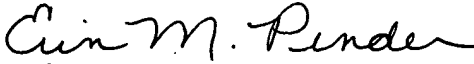
Applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



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